

*JF**HN***TRANSMITTAL FORM**

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Confirmation # 9293

Filing Date 07/23/2003

First Inventor ANDERSON, Glen

Art Unit 3625

Examiner J. Dunham

Docket # P1933US00 (P09008US00)

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fees calculated below	<input type="checkbox"/> Response to Missing Parts/Incomplete Appl.
<input checked="" type="checkbox"/> Request For Reconsideration	<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> including Attachment(s)	<input type="checkbox"/> Information Disclosure Statement
<input type="checkbox"/> After Final Amendment/Reply	<input type="checkbox"/> Drawing(s)
<input type="checkbox"/> including Attachment(s)	<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Extension of Time Petition	<input type="checkbox"/>
<input type="checkbox"/>	<input type="checkbox"/>

FEES CALCULATION: For claims if required and/or other fees as shown below:

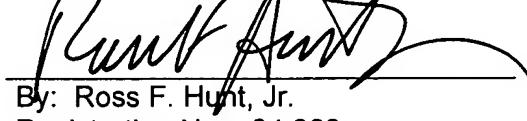
	NOW	Previously Paid For	Present Extra	Rate	\$
<input checked="" type="checkbox"/> TOTAL CLAIMS	18	20	0	X \$ 50 =	
<input checked="" type="checkbox"/> INDEPENDENT CLAIMS	3	3	0	X \$ 200 =	
TOTAL OF ABOVE CLAIMS FEES =					
<input type="checkbox"/> Reduction by ½ for small entity status of applicant					SUBTOTAL =
<input type="checkbox"/> Fee for extension of time (per attached Petition)					
<input type="checkbox"/> Other fee for					
TOTAL OF ALL FEES =					

The Commissioner is hereby authorized to charge the above-noted fee of \$ to Deposit Account No. 50-0439.

The Commissioner is authorized to charge any fee, additional fee or extension fee due in connection herewith to Deposit Account No. 50-0439:

(1) if no payment or an insufficient payment is enclosed and a fee is due in connection herewith; or
(2) if no petition for extension of time is enclosed but an EOT is required - and in this event, applicant hereby petitions under 37 CFR 1.136(a) for an extension of time of as many months as are required to render this submission timely. The Commissioner is hereby authorized to charge any such fee to Deposit Account No. 50-0439

Date: January 5, 2007


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**REQUEST FOR
RECONSIDERATION**

Application #	10/625,252
Confirmation #	9293
Filing Date	July 23, 2003
First Inventor	ANDERSON
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Examiner	Dunham, Jason B.
Docket #	P1933US00 (P09008US00)

Commissioner for Patents
P.O. Box 1450
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SIR:

Claims 1-18 have been rejected under 35 USC 103(a) as being "unpatentable over" Roth in view of Kiely. This rejection is respectfully traversed.

As discussed in the prior response, Roth discloses an Internet advertising system wherein advertisements are provided from a central server to viewers who access websites. The central server stores both advertisements and an information database. Proposed bids are submitted by different advertisers and are evaluated in real-time in order to determine which particular advertisement will be displayed to a viewer. Each proposed bid specifies a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement to a viewer and on a website. Bidding agents compare the characteristics of "view-ops" to the specifications in the proposed bids, and submit the bids, as appropriate, to bid selection logic. The latter decides which bid to accept for each particular view-op.

As was also discussed in the prior response, Kiely discloses an upsell system and method for use on the worldwide web. Upsell offers are presented to customers who have placed orders with a website, by a third party upsell server. At or near the completion of a transaction, transaction details are communicated to the third party upsell server. The latter then provides an offer directly to the customer. If the customer

accepts the offer, an upsell order is processed by the upsell server in a manner that is said, in Kiely, to be “seamless” to the customer. As set forth in paragraph [0027] an “upsell” involves a situation wherein after an order is submitted, but before control of the client system is returned to the customer, a mechanism is implemented to provide an additional or post-sale offer to the customer. The idea is to make a further offer to the customer while the customer is already in a buying mode and thus more likely to accept a further offer.

Turning to the present invention, and considering claim 1 as exemplary, the present invention as claimed in claim 1 relates to a method for providing one or more real-time marketing opportunities to third parties during a sale transaction between a customer and a seller purchasing a product. The real-time marketing opportunity is offered by the seller. This is entirely different from Roth wherein proposed bids are submitted by different advertisers completely independent of any particular sale in progress, i.e., without reference to a “sales transaction between a customer and a seller for purchasing a product.”

Claim 1 also provides for “issuing an alert over an established connection to third parties that the sales transaction is in progress and a bidding process is opened for soliciting bids on at least one of the one or more real-time marketing opportunities in question.” Claim 1 further provides that one or more bids are received from one or more of the third parties and also recites that a determination is made of a winning bid for each of the one or more real-time marketing opportunities included in the bidding process based on the one or more bids received.

It is respectfully submitted that the bidding process claimed in claim 1 clearly distinguishes from the Kiely patent wherein there is no bidding process, but wherein, instead, upsell offers are presented to customers who have placed orders with a website. The upsell offer is made by a single third party upsell server, and, again, there is no involvement in a bidding process by a plurality of third parties. In the latter regard, claim 1 and the other independent claims recite that the alert is issued to "third parties" (rather than "one or more" third parties) so that the recitation "bidding process" has more meaning (a bidding process, as that term would normally be understood, would not involve only a single bidder).

It is, of course, recognized that the rejection here is based on a combination of the two references and that the rejection cannot be overcome by simply attacking the two references individually. However, it is respectfully submitted that it would not be obvious to combine the Roth and Kiely references in the manner proposed by the Examiner. The Roth patent relates to a relatively straightforward Internet advertising system wherein proposed bids submitted by different advertisers are evaluated and a decision is then made as to which bid to accept. The Kiely patent concerns a much different type of system which is exclusively concerned with upsell offers and which has nothing to do with bidding by third parties.

Considering the latter point in more detail, it is respectfully submitted that the Kiely patent does not disclose issuing an alert over an established connection to multiple third parties that a sales transaction is in progress and that a bidding process is open for bidding. Specifically, contrary to the contention in the Office Action, the abstract in Kiely (to which the Examiner has made reference as disclosing this feature)

simply provides that transaction details are communicated to a third party upsell server that provides an offer directly to the customer. As explained in paragraph [0028] of Kiely, in implementing the upsell process, the customer is notified of a post-sale opportunity during the transaction, and the “opportunity” is a notification to the customer that the customer is being given an opportunity to make an additional transaction, e.g., through the use of a pop-up window or an upsell script.

Further, applicant again respectfully takes issue with the manner in which the claims are being read on the references, i.e., it is respectfully submitted that it is improper to simply read one aspect of the claim on one reference and another aspect of the claim on another reference without establishing a clear basis for combining the references. In this regard, applicant disagrees with the contention that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Roth to have included issuing an alert to third parties during the sales transaction that a bidding process is open, as taught by Kiely, in order to provide direct marketing access to customers.

Considering the latter point in more detail, first, it is respectfully submitted that paragraph [0004] cited by the Examiner has nothing to do with this aspect of the invention, and merely discusses, in general terms, the shortcomings of current methods for putting sales offers in front of potential customers in a web setting.

Regarding paragraph [0010] and Figure 3, also relied on by the Examiner, paragraph [0010] is merely a straightforward paraphrase of claim 22, and the language on which the Examiner relies and the corresponding subject matter are not otherwise disclosed in Kiely. In this regard, Figure 3 relates to an embodiment of the invention

employing an upsell hub 56 which acts as a broker for upsell opportunities. As stated in this paragraph, “when an affiliate 54 substantially completes a transition with a client 60, an upsell opportunity can be transmitted to upsell hub 56, which will in turn select a third party upseller system 58 to handle the actual upsell processing with client 60.” Thus, the selection is made by hub 56 based on upsell opportunities stored by the hub 56 and received from the various third party upseller systems 58. This clearly no bidding and no notification of bidding and, moreover, the selection is apparently made based on information previously provided by the various upseller systems 58.

Turning to the “Response to Arguments” section, the point raised in the fourth paragraph has just been addressed.

Regarding the second paragraph, and the embodiment to Kiely to which the Examiner makes reference, transaction details are, indeed, communicated to a third party upsell server and, in this embodiment, the upsell server provides an offer directly to the customer. However, this is completely different from a bidding process and, in this embodiment of Kiely, transaction details are communicated to a single third party upsell server. This is in contrast to the above-described embodiment of Figure 3 wherein an upsell hub is used which selects between multiple offerings from a plurality of upsell servers.

Regarding the third paragraph of the “Response to Arguments” section, it is respectfully submitted that the quoted case law that “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art" is particularly apposite here. The Examiner states in support of the obviousness of combining the references that "[i]n this case, Roth and Kiely both provide methods for providing real-time marking opportunities to third parties." It is respectfully submitted that this very general relationship between the two references is not a basis for combining them. As discussed above, the two systems are quite different, one being directed to a basic bidding technique and the other being concerned with upselling to customers who have placed orders with a website. Given these fundamental differences, one of ordinary skill in the art would simply have not thought to combine the teachings of these two references without the benefit of the improper use of hindsight.

Allowance of the application in its present form is respectfully solicited.

Respectfully submitted,

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